

**REMARKS*****Status of the Claims***

Claims 1, 6-9, 16, 17, 19, 22-25, 27-32, 34-48, and 56-90 are pending in the application. By this Amendment, claims 1 and 22 have been amended and claims 21 and 33 have been cancelled. Exemplary support for the claim amendment can be found throughout the specification and claims as originally filed. See, for example, cancelled claims 21 and 33.

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

***Restriction Requirement***

Applicants respectfully traverse the Restriction Requirement as set forth in the Office Action dated October 9, 2007. Moreover, Applicants respectfully assert that the inventions of both groups (group I: claims 1, 6-9, 16, 17, 19, 22-25, 27-32, and 34-48; and group II: claims 56-90) should properly be examined together. Both groups have the goniochromatic coloring agent in common. Therefore, Applicants respectfully submit that both groups are closely related.

Applicants submit that the inventions of both groups are closely related and that a proper search of any of the claims should, by necessity, require a proper search of the others. Thus, Applicants submit that all of the claims can be searched simultaneously, and that a duplicative search, with possibly inconsistent results, may occur if the restriction requirement is maintained.

Applicants submit that any nominal burden placed upon the Examiner to search accordingly to determine the art relevant to Applicants' overall invention is significantly outweighed by the public's interest in not having to obtain and study many separate patents in order to have available all of the issued patent claims covering Applicants' invention. The alternative is to proceed with the filing of numerous applications, each consisting of generally the same disclosure, and each being subjected to essentially the same search, perhaps by different Examiners on different occasions. This process would place an unnecessary burden on both the Patent and Trademark Office and on the Applicants.

Regardless of whether the two groups are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. M.P.E.P. § 803 requires that "[i]f the search and examination of an entire application can be made without

serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Nevertheless, it appears that the Examiner has indicated the Applicants have constructively elected group I (*i.e.*, claims 1, 6-9, 16, 17, 19, 22-25, 27-32, and 34-48). Without conceding the propriety of the Restriction Requirement and merely in the interest of expediting prosecution, Applicants elect group I (*i.e.*, claims 1, 6-9, 16, 17, 19, 22-25, 27-32, and 34-48) with traverse. However, Applicants specifically note that Applicants have no intention of abandoning any non-elected subject matter and should it be necessary, Applicants expressly reserve the right to file one or more continuation and/or divisional applications directed to non-elected subject matter.

### ***Rejection under 35 U.S.C. § 102***

Claims 1, 6-9, 16, 17, 19, 21-25, 27, 28, 30, 33-41, 43-45, and 47 have been rejected under 35 U.S.C. § 102(a) as allegedly anticipated by WO 01/51015 (hereinafter "Oko"). This rejection is respectfully traversed.

It should be noted that a claim is anticipated only if ***each and every*** element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

Oko discloses a cosmetic make-up product comprising a particular pigment having four layers, in combination with a traditional interference pigment. (Page 2, lines 9-12). According to Oko, this combination leads to highlight the natural relief of the face and body's contours. (Page 2, lines 19-21). More particularly, according to Oko, this combination allows obtaining a variety of different shades, without altering the desired light-to-dark shift effect, leading to emphasize the contours of different areas of the face and body. (Page 3, lines 16-21).

The Examiner seems to have deduced from the foregoing that the traditional interference pigments, which are used in combination with the four-layered pigment is inherently the same as the reflective particles according to those recited in claim 1 and have

inherently the same particle size(s) as recited in claims 23 to 25. (See Page 3 of Office Action). We disagree with the Examiner's position for at least the reasons set forth hereinbelow.

A list setting forth the traditional interference pigments, which may be used in Oko's composition, according to Oko at page 3, line 23 through page 4, line 11, does not include the presently recited *light reflective particles* different from said at least one goniochromatic coloring agent, wherein *the light reflective particles are particles of a synthetic substrate made from glasses, the light reflective particles are at least partially coated with at least one layer of at least one metallic compound having a spectral reflectance in the visible spectrum of at least 70% and not being greater than 250  $\mu\text{m}$  in size.*

Applicants respectfully submit that Oko not only fails to disclose the presently recited *reflective particles*, in general, let alone disclosing that the presently recited *light reflective particles are particles of a synthetic substrate made from glasses, the light reflective particles are at least partially coated with at least one layer of at least one metallic compound having a spectral reflectance in the visible spectrum of at least 70% and not being greater than 250  $\mu\text{m}$  in size.*

Moreover, Applicants respectfully submit that the presently recited *reflective particles* and Oko's traditional interference pigments are different in terms of function and structure. In this regard, Applicants respectfully submit that Oko discloses at page 3, lines 17-19 that the standard interference pigments allow obtaining a variety of different shades. In contrast, the presently recited *reflective particles* reflect the incident light with an intensity sufficient to be able to create at the surface of the claimed composition, when said composition is applied to the support to be made up, highlight points that are visible to the naked eye, *i.e.*, more luminous points that contrast with their surroundings by appearing to shine. (Pages 4-5, paragraph [0020] of the present specification). Such highlight points may be created by particles being limited in size. (Page 11, paragraph [0053] of the present specification). Applicants respectfully submit that only particles having a small size may create such highlight "points".

Accordingly, Applicants respectfully submit that such a particle size limitation is not required by Oko for conventional interference pigments in order to create shades of larger areas. Thus, Applicants respectfully submit that Oko's traditional interference pigments are functionally (*i.e.*, creating highlight points on the surface of the composition once applied

compared with creating shades) and physically (*i.e.*, size not greater than 250  $\mu\text{m}$  and metal coated glass particles) different.

As such, Applicants respectfully submit that the presently recited composition comprising such *reflective particles* is patentable over Oko for at least the foregoing reasons.

***Rejections under 35 U.S.C. § 103***

(i) Claims 31, 32, 46, and 48 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Oko and further in view of FR 2777178<sup>1</sup> (hereinafter "Simon") . The rejection is respectfully traversed. This rejection is respectfully traversed.

The Office has the initial burden of establishing a *factual basis* to support the legal conclusion of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some *articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

As discussed hereinabove, Oko does not disclose the presently recited *reflective particles* and nothing within the disclosure of Oko would have motivated a person of ordinary skill in the art to use the presently recited *reflective particles* in Oko. In this regard, the discussion hereinabove regarding Oko is incorporated herein in its entirety.

More particularly, as explained above, the presently recited *reflective particles* and Oko's standard interference pigments are physically (*i.e.*, size not greater than 250  $\mu\text{m}$  and metal coated glass particles) and functionally (*i.e.*, creating highlight points on the surface of the composition once applied compared with creating shades) different.

With regard to Simon, it should be noted that Simon discloses a cosmetic product comprising a first composition containing goniochromatic pigments and a second composition comprising monochromatic pigments which are illustrated by an aqueous

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<sup>1</sup> It should be noted that both the Office Action and the arguments herein rely upon U.S. Patent No. 6,451,294 as the English Equivalent of this document.

dispersion of TiO<sub>2</sub>. (Col. 1, lines 13-17 and Examples at Col. 9).

Applicants respectfully submit that a goal of Simon is to increase the goniochromatic effect of the goniochromatic pigments by associating them with conventional dyes.

Applicants respectfully submit that Simon does not disclose or suggest the presently recited *reflective particles*.

As such, Applicants respectfully submit that Simon fails to cure the many above-noted deficiencies of Oko. Accordingly, Applicants respectfully submit that the obviousness rejection over Oko and Simon should be withdrawn.

(ii) Claims 1, 6-9, 16, 17, 19, 27-29, and 33-48 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,759,052 (hereinafter "Suzuki") in view of Applicants own disclosure and FR 2816830<sup>2</sup> (hereinafter "Blin"). The rejection is respectfully traversed.

As noted above, the Office has the initial burden of establishing a *factual basis* to support the legal conclusion of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some *articulated reasoning with some rational underpinning* to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (emphasis added).

Suzuki discloses a cosmetic composition comprising titanium dioxide coated glass flake. (Example 11). However, it should be noted that Suzuki does not disclose or suggest the presently recited goniochromatic coloring agent much less a combination of the titanium dioxide coated glass flake with a goniochromatic coloring agent.

In contrast, amended independent claim 1 recites, *inter alia*, ***at least one goniochromatic coloring agent***, and ***light reflective particles*** different from said at least one goniochromatic coloring agent.

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<sup>2</sup> It should be noted that both the Office Action and the arguments herein rely upon U.S. Pre-Grant Publication No. 2004/0076649 as the English Equivalent of this document.

However, it should be noted that Suzuki does not disclose or suggest the presently recited goniochromatic coloring agent much less a combination of the titanium dioxide coated glass flake with a goniochromatic coloring agent.

Furthermore, Applicants respectfully submit that the purpose and solution of Suzuki are far from those addressed in the present disclosure. Applicants also respectfully submit that Suzuki intends to provide cosmetic composition exhibiting good dispersing ability of powder by using derivatives of inulin associated with cyclic silicone oil. (Col. 1, lines 8-16, 25-26, and 34-38; Col. 2, lines 33-40; and Col. 3, lines 47-55).

Blin addresses the issue of improving and easing the dispersion of fibers for preparing a homogeneous cosmetic composition (see, page 1, paragraphs [0001] and [0004]), and proposes to rely upon an appropriate selection of fibers on the basis of the flattened shape of their section. (Col. 1, paragraph [0007]).

In contrast, amended independent claim 1 recites, *inter alia*, ***at least one goniochromatic coloring agent***, and ***light reflective particles*** different from said at least one goniochromatic coloring agent, wherein ***the light reflective particles are particles of a synthetic substrate made from glasses, the light reflective particles are at least partially coated with at least one layer of at least one metallic compound having a spectral reflectance in the visible spectrum of at least 70% and not being greater than 250 μm in size.***

Applicants respectfully submit that Blin does not disclose or suggest the presently recited ***reflective particles*** much less their use in combination with the presently recited ***goniochromatic coloring agents***.

Furthermore, Applicants respectfully submit that the purpose of Blin's flat fibers is to impart good feel and mechanical resistance. (Page 1, paragraphs [0009]-[0010]). Accordingly, Applicants respectfully submit that Blin's objectives are unrelated with the objectives of pending claims including the effects of the presently recited ***reflective particles***. As such, one of ordinary skill in the art would not have consulted Blin to obtain the pending claims.

Applicants respectfully submit that one of ordinary skill in the art would have found no motivation to combine the pigments respectively described in Blin and Suzuki into one cosmetic composition, because each document describes specific cosmetic compositions which may comprise only one of the pigments presently recited. Moreover, Applicants

respectfully submit that Suzuki and Blin's compositions have different purposes *i.e.*, to impart good feel and mechanical resistance (as disclosed in Blin) or to provide a cosmetic composition exhibiting good dispersing ability of powder (as disclosed in Suzuki).

Accordingly, Applicants respectfully submit that one of ordinary skill in the art cannot find in Suzuki or Blin any guidelines that would have pointed out the advantage of selecting and combining the presently recited *at least one goniochromatic coloring agent*, and *light reflective particles* different from said at least one goniochromatic coloring agent, wherein *the light reflective particles are particles of a synthetic substrate made from glasses, the light reflective particles are at least partially coated with at least one layer of at least one metallic compound having a spectral reflectance in the visible spectrum of at least 70% and not being greater than 250  $\mu\text{m}$  in size*, in order to obtain the presently recited volumizing effect.

As such, Applicants respectfully submit that the obviousness rejection over Suzuki and Blin should be withdrawn for at least the foregoing reasons.

### ***Double Patenting***

Claims 1, 6-9, 16, 17, 19, 21-25, and 27-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 66-73, 111-124, 143, and 144 of co-pending Application No. 10/432,329 ("the '329 application") in view of Suzuki.

Applicant believes that the present claims are patentable over the claims of the '329 application in view of Suzuki. However, to facilitate allowable subject matter, a terminal disclaimer over the '329 application will be submitted under separate cover, as appropriate, once allowable subject matter has been agreed upon.

It should be noted that the filing of a Terminal Disclaimer is not to be construed as an admission of the propriety of the rejection on obvious double patenting. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

***Conclusion***

Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below if any issues remain in this matter, or if a discussion regarding any portion of the application is desired by the Examiner.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,

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